

STATUS OF THE CLAIMS

The claims have been amended herein to correct errors and simplify the claim structure in view of the elected subject matter and comments below. Claims 37 and 38 have been added to include elements that were optionally included in the claims from which they depend. Applicants reserve the right to prosecute non-elected subject matter in one or more continuing application(s).

RESPONSE TO RESTRICTION REQUIREMENT

In response to the restriction requirement which the Examiner imposed, Applicants elect, with traverse, to prosecute the Group I claims, *e.g.*, claims 1-4, and further elect the sequences of (A), *e.g.*, SEQ ID NO:1 or a sequence encoding SEQ ID NO:2. In response to the species election requirement, Applicants elect species vii), identified as including the chlorophyllase and dxs sequences. All of the elected claims read on the elected species. Applicants request examination of all species upon the allowability of a generic claim.

Applicants respectfully traverse the restriction between Groups I-III on the basis that all of the Group III claims as identified in the Restriction Requirement are generically linked by the Group I claims and further because there would be no additional burden in examining the Group III claims together with the Group I claims. In particular, all of the Group III claims, claims 5-24, are directed to transformed plants, seeds and their methods of making that require a nucleic acid according to Group I. The Group III claims are thus generically linked by the Group I claims because they incorporate the limitations of the Group I claims. The Group III claims therefore must be examined together with the elected invention. Specifically, in a restriction requirement, generic or other linking claims must be examined with the linked inventions and the presence of the linking claim should be clearly noted on the record. See MPEP §814. Here, the

relevant claims incorporate the limitations of Group I nucleic acids and therefore are generically linked. *Id.*

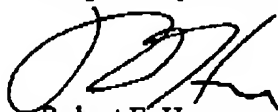
In regard to the foregoing Applicants respectfully draw attention to the decision by the Court of Appeals for the Federal Circuit in *In re Michael P. Doyle*, which noted that an applicant may prosecute generic, linking claims “without running afoul of the restriction requirement *because they are linking claims.*” 293 F.3d 1355, 1360 (Fed. Cir., 2002), *citing* MPEP §809.03 (8th ed. 2001) (emphasis added). Indeed, the Court held that the failure to present generic claims in the original prosecution of an application was an error correctable by broadening reissue. *Id.* at 1361-1362. Further, the Federal Circuit noted that allowance of a linking claim prompts the examination of covered claims, stating that “[t]he MPEP expressly provides that ‘[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.’” *Id.* at 1362., *citing* MPEP § 809.04 (emphasis added by the Court). Consideration of the claims on this basis is thus requested.

Applicants additionally note that the M.P.E.P. requires that “[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (emphasis added) M.P.E.P. §803. Here, a search and examination of all linked claims would not cause a serious burden because the relevant claims incorporate the limitations of the Group I claims. Therefore, upon a searching and determination that the Group I claims are novel and nonobvious, there is *no* additional burden in searching the Group III claims because they must by definition also be novel and nonobvious. The relevant standard in the M.P.E.P. requires a *serious* burden on the examiner in order to support a proper restriction. The relation among the

claims here eliminates any such serious burden. Examination of all of the Group I and III claims is thus respectfully requested.

The Examiner is invited to contact the undersigned attorney at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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